

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application Of	:	
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Wesley W. Whitmyer, Jr.	:	
	:	Examiner: Alam, Shahid Al
	:	
Serial No.: 09/725,394	:	Group Art Unit: 2162
	:	
Filed: November 29, 2000	:	Confirmation No. 9725
	:	
For: Web Site Automating Transfer	:	
Of Intellectual Property	:	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Reply Brief Under 37 CFR §41.41

Dear Sir:

Having received the Examiner's Answer, Appellant submits this Reply Brief for the above-captioned application pursuant to 37 C.F.R. §41.41 as follows.

Most of the arguments presented in the Examiner's Answer were presented during prosecution, and thus, have already been dealt with in Appellant's Appeal Brief. Appellant submits this Reply to briefly elaborate on issues raised in the Examiner's Answer.

Rejection Of Claims 1-10 Under 35 U.S.C. § 103(a) Over U.S. Patent No. 5,987,464 (“Schneider”) In View Of U.S. Patent No. 6,766,305 (“Fucarile”)

Neither Schneider nor Fucarile teach, disclose or suggest software executing on the Internet server for querying the database of information records to retrieve an information record corresponding to a transfer request, for querying the database of recordation forms to retrieve a recordation form corresponding to the transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a transfer document. In addition, claims 2, 4 and 9 further recite that the property is intellectual property such as patents, copyrights, and trademarks.

The Examiner has stated that the “broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).” Appellant agrees. In discussing Fucarile, the Examiner noted that “[e]ach of the license records includes an identification of a licensee and an associated level of functionality for that licensee. This information is used to define an access policy for the licensee that is used to determine what access is granted to the licensee to the software items.” (Examiner’s Answer, p. 12.)

Fucarile is directed to a system that licenses users to use or have access to software, not to a system for automating the recordation of a property transfer as recited in all of the claims. Licensing the use of software is not equivalent to transferring ownership of a property, such as, for example a patent. As Fucarile

is only directed toward a system for licensing use of information/software, there is no need to generate a “transfer document” that may be filed with, for example, the U.S. Patent Office to record the transfer.


Rather than address this discrepancy, the Examiner simply states that “Fucarile teaches licensing system same as Intellectual Property system and hence, Fucarile reference is analogous art same as Instant application.” (Examiner’s Answer, p. 13.) A system licensing software is not equivalent to a system for transferring ownership of property. The ownership of the software remains with the company that licenses the use of it. In addition, there is no need or requirement to generate a “transfer document”, which includes information specific to the property to be transferred and a recordation form corresponding to the transfer request that can be filed with a government agency.

The Examiner further goes on to state that “Fucarile discloses in Figure 4 a License Server and License Database and its corresponding text teaches the License form, which contain at least a portion of the encoded information. Fucarile discloses form similar to instant application.” (Examiner’s Answer, p. 13.) As stated earlier, the “broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). One of ordinary skill in the art of property transfer would realize that the licensing

system in Fucarile can not accomplish transfer of ownership of a property, but rather is limited to licensing the use of the property. At the very least, one of ordinary skill would realize that the system of Fucarile doe not even hint at a system that combines an information record with a recordation form to generate a transfer document that could be used to transfer intellectual property ownership.

Respectfully submitted,

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Todd M. Oberdick, Registration No. 44,268
Steven B. Simonis, Registration No. 54,449
ST. ONGE STEWARD JOHNSTON & REENS
986 Bedford Street
Stamford, Connecticut 06905
(203) 324-6155

Attorneys for Appellant